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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/941,459	09/30/97	MORIKAWA	T 05058/58201

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EXAMINER

NGUYEN, J

ART UNIT

PAPER NUMBER

2722

DATE MAILED: 01/28/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/941,459

Applicant(s)
Takeshi Morikawa

Examiner
Jimmy Nguyen

Group Art Unit
2722

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above, claim(s) 1-3, 7-12, and 17-22 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 4-6, 13, and 23 is/are rejected.
- ☒ Claim(s) 14-16 and 24-26 is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 7-12, and 17-22, drawn to an display control unit, classified in class 358, subclass 468.
 - II. Claims 4-6, 13-16 and 23-26, drawn to a print prevention control unit ; classified in class 395, subclass 113.
2. The inventions I and II are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Invention in this relationship are distinct if it can be shown the (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the display control unit of Group I does not require the particular print prevention control unit of Group II. The subcombination has separate utility such as a selection prohibiting controller.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. James W. Williams on January 7, 1999, a provisional election was made with traverse to prosecute the invention of Group II, claims 4-6,

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13-16, and 23-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-3, 7-12, and 17-22 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **4, 13, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsumi et al. in view of Mori et al.

Regarding claims **4, 13, and 23**, Mori et al. discloses an image forming apparatus, the apparatus teaches: an operation panel for selecting any of plurality of modes of operation (refer to figure 13); a memory for storing image data of a plurality of frames (refer to column 19 lines 46-48); a print-job selector for selecting one of print jobs stored in memory (refer to column 20 lines 49-52 note: second input refer as a print-job selector); a printer for reading image data stored in memory for each frame and for printing (refer to column 19 lines 61-67); a state decision controller for determining a state of image data stored in memory for each frame (refer to column 19 lines 49-51). However, Mori et al. does not teach: a selection prohibiting controller for

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prohibiting selecting an inoperable mode of operation of plurality of modes of operation through operation panel according to the state of image data. Tsutsumi et al. teach: a selection prohibiting controller for prohibiting selecting an inoperable mode of operation of plurality of modes of operation through operation panel according to the state of image data(refer to column 2 lines 11-22). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine Tsutsumi et al. into Mori et al's system. Such combination would reduce operation errors by the user.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsumi et al. and Mori et al. as applied to claim 4 above, and further in view of Ishiguro et al.

Regarding claims 5 and 6, Tsutsumi et al. and Mori et al. discloses all of the limitation except: wherein state decision controller determines a length of a frame of image data in a predetermined direction and wherein state decision controller determines a frame size of image data. Ishiguro et al. teaches: state decision controller determines a length of a frame of image data in a predetermined direction and wherein state decision controller determines a frame size of image data (refer to column 5 lines 25-30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine Ishiguro et al. into Tsutsumi et al. and Mori et al's system. Such combination would reduce operation errors by the user.

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Claim Objections

8. **Claims 14-16 and 24-26** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

None of the prior art, whether taken alone or in combination teaches the step selection prohibiting controller prohibits selecting a staple print mode through operation panel when it is determined that memory includes image data different in frame size from other image data stored in memory, staple print mode being provided so that finisher provides a staple processing; the step selection prohibiting controller prohibits selecting a two-side print mode through operation panel when it is determined that memory includes image data different in frame size from other image data stored in memory, two-side print mode being provided so that finisher provides for printing image data stored in memory on both sides of a sheet; selection prohibiting controller prohibits selecting an economy print mode through operation panel when it is determined that image data stored in memory all have a same frame size, economy print mode being provided for printing image data of a plurality of frames on one same side of a sheet;

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Nguyen whose telephone number is (703) 305-2725. The examiner can normally be reached on M-F from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5397.



JIMMY NGUYEN



EDWARD L. COLES
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GROUP 2700